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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,674	08/02/2001	Salim A. Nathoo	NAT 003 PAT	6752

7590 06/11/2003  
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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/920,674

Applicant(s)

NATHOO, SALIM A.

Examiner

Clinton Ostrup

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/21/03.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5,6,8-13 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6, and 8-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3,5,6,8-13 and 19 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

Claims 1-3, 5-6, 8-13, and 19 are pending in this application.

***Oath/Declaration***

Applicant's submission of a new oath/declaration, filed March 21, 2003, Paper No. 7, has made the objection to the oath in Paper No. 5, moot. Therefore, said objection has been withdrawn.

***RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS***

***Claim Objections***

Applicant's amendment filed March 21, 2003, Paper No. 8, has made the objections to claims 2, 4, 7, 8, and 14 moot. Therefore, the said objections have been withdrawn.

***Election/Restrictions***

Applicant's election of claims 1-13 and claim 19 in Paper No. 19 has previously been acknowledged. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

However, process claim 19 is hereby restricted from examination until allowable subject matter is indicated. Claim 19 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable

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generic or linking claim, currently claim 1 is generic. The election of Group I, claims 1-13 was made **without** traverse in Paper No. 4.

A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Specification***

Applicant's submission of new application papers with lines double spaced on good quality paper, filed March 21, 2003, Paper No. 6, has made the objection to the specification moot. Therefore, the said objections have been withdrawn.

***Claim Rejections - 35 USC § 112***

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~~Applicant's amendment filed March 21, 2003, Paper No. 8, has made the~~  
rejection of claims 1-13 under 35 U.S.C. 112, second paragraph, moot. Therefore, the said rejection has been withdrawn.

***Claim Rejections - 35 USC § 102***

Applicant's amendment and arguments filed March 21, 2003, Paper No. 8 to the rejection of claims 1, 4, 5, 7, 8, and 11 as being anticipated by Frazier et al., 4,980,152 have been fully considered, however, they have not been found convincing. Therefore the said rejection has been MAINTAINED for the reasons set forth in the previous Office Action, Paper No. 5, mailed December 31, 2002 and those found below.

Applicant argues that the "Frazier patent does not share an identity of purpose with the instant invention in that Frazier makes no claim for whitening teeth." A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the compositions of Frazier et al are all drawn to dentifrice compositions, thus meeting the composition limitations, as claimed instantly.

Applicant argues that the compositions of examples 5 and 6 do not teach DEQUEST 2010, pyrophosphate, and fluoride as chelating agents. First, these arguments are not commensurate with what is being claimed instantly. None of the instant claims require DEQUEST 2010, only claim 10 teaches makes any mention of

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pyrophosphate, and claim 11 is the only claim comprising fluoride. In fact, none of the instant claims contain the combination of ingredients DEQUEST 2010, pyrophosphate, and fluoride.

Applicant then goes on to argue that Frazier et al., teaches a thickening system comprising Polaxamer, carboxymethylene, and cellulose esters, whereas the instant invention makes exclusive use of Polaxamer. It should be remembered that the instant claims use open-ended terminology, thus, they are not limited to one thickening material. Moreover, none of the instant claims require Polaxamer as a thickener.

In response to applicants argument that claims 10 of Frazier teaches a hydrocarbon humectant, whereas the instant invention is drawn to a composition free of hydrocarbon humectants, the examiner respectfully points out that examples 5 and 6 do

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not contain a hydrocarbon humectant, thus, the instant claims are anticipated.

Therefore, the said rejection has been MAINTAINED.

***Claim Rejections - 35 USC § 103***

Applicant's amendment and arguments filed March 21, 2003, Paper No. 8 to the rejection of claims 1, 4-8, and 11-12 as being unpatentable over Frazier et al., 4,980,152 and further in view of Oxman et al., 6,312,666 have been fully considered, however, they have not been found convincing. Therefore the said rejection has been MAINTAINED for the reasons set forth in the previous Office Action, Paper No. 5, mailed December 31, 2002 and those found below.

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~~Applicant argues that the combination of Frazier et al., 4,980,152 and Oxman et~~  
al., 6,312,666 does not make the instant invention obvious because Oxman shows a low viscosity liquid, which gels when placed on the teeth and does not teach a mixed metal chelating system comprising DEQUEST 2010, pyrophosphate, and fluoride nor the use of sodium lauryl sulfate. As described above, none of the instant claims require DEQUEST 2010, pyrophosphate, and fluoride. With respect to applicant's argument that Oxman does not teach sodium lauryl sulfate, this rejection is based on the combination of Frazier et al and Oxman et al and Frazier et al teaches the commonly used surfactant sodium lauryl sulfate. Moreover, this reference was used for its teaching of whitening teeth using the specific peroxide of claim 6.

Applicant's amendment and arguments filed March 21, 2003, Paper No. 8 to the rejection of claims 1-8, and 10-13 as being unpatentable over Frazier et al., 4,980,152 and Oxman et al., 6,312,666 and further in view of Day 6,312,666 and Clipper et al.,

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4,537,778 have been fully considered, however, they have not been found convincing.

Therefore the said rejection has been MAINTAINED for the reasons set forth in the previous Office Action, Paper No. 5, mailed December 31, 2002 and those found below.

Applicant argues that Day teaches the preparation of clear gel dentifrice compositions, containing abrasives and humectants and does not teach whitening of teeth. First, the whitening of teeth is an intended use of the composition and is not given patentable weight in composition claims. However, as discussed in the previous Office Action, Day was relied upon for the chelating system of instant claim 2, and Clipper was used to teach the specific surfactant system of claims 9-10. Moreover, the rejection was based on the combination of references, wherein, the secondary

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reference, Oxman et al., clearly teaches the whitening of teeth. Therefore, applicants arguments have not been found convincing and the said rejection has been MAINTAINED.

#### **MAINTAINED CLAIM REJECTIONS**

##### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4, 5, 7, 8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Frazier et al., 4,980,152.

Frazier et al., teaches making clear gel compositions comprising hydrogen peroxide, Pluronic F127, citric acid, sodium fluoride, and water. See: col. 4, example 5 and col. 5, example 6. Pluronic F127 is the specific polyoxyethylene-polyoxypropylene

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non-ionic surfactant gelling agent used in the instant invention, and sodium fluoride is a catalase-inhibiting compound. Therefore, the composition as claimed instantly in claims 1, 4, 5, 7, 8, and 11 are clearly taught by Frazier et al.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4-8, and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frazier et al., 4,980,152, as applied to claims 1, 4, 5, 7, 8, and 11 above, and further in view of Oxman et al., 6,312,666.

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~~Frazier et al., teaches making clear gel compositions comprising hydrogen~~  
peroxide, Pluronic F127, citric acid, sodium fluoride, and water. See: col. 4, example 5 and col. 5, example 6. Pluronic F127 is the specific polyoxyethylene-polyoxypropylene non-ionic surfactant gelling agent used in the instant invention, and sodium fluoride is a catalase inhibiting compound, thus the composition comprising the compounds of the tooth bleaching composition, as claimed instantly in claims 1, 4, 5, 7, 8, and 11 are clearly taught by Frazier et al. The primary reference claims sodium lauryl sulfate in the gel compositions and therefore teaches instant claims 3 and 20. See: claims 1-5 and 20. The primary reference teaches sodium hydroxide added to potassium phosphate as a buffering agent.

Although Frazier et al., teach the specific compounds of claims 1, 4, 5, 7, 8, and 11, the reference lacks the peroxide of instant claim 6.



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Oxman et al., teach compositions and methods of using the compositions for whitening teeth. The secondary reference teaches whitening agents as being selected from hydrogen peroxide and its urea complex, carbamide peroxide, which are known in the art. The secondary reference teaches tooth-whitening gels comprising Pluronic F127, hydroxide, and water.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Frazier et al., by using carbamide peroxide, a well known hydrogen peroxide complex because of the reasonable expectation of obtaining a tooth whitening gel composition comprising a hydrogen peroxide compound that would provide similar tooth whitening properties.

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Claims 1-8, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frazier et al., 4,980,152 and Oxman et al., 6,312,666 as applied to claims 1, 4-8, and 11-12 above, and further in view of Day 6,479,038 taken with Clipper et al., 4,537,778.

The combined references above teach tooth whitening gel compositions comprising a polyoxyethylene-polyoxypropylene non-ionic surfactant, peroxide, water, and a catalase inhibitor, as described above, however the combined references lack the specific chelating system of instant claim 2, the chelating agent of claims 9 and 10, and the surfactant of claim 13.

Day teaches clear dentifrice gel compositions comprising the specific chelating system of instant claim 2, that is an organic chelating agent, a condensing phosphate chelating agent, and a metal precipitating agent.

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Clipper et al., teach aqueous oral gel compositions comprising a surfactant system, which comprises a Pluronic type and a polysorbate type surfactant. The secondary reference specifically teaches Tween 20 as the polysorbate type surfactant, thus meeting the limitation of instant claim 13. The reference teaches gel compositions comprising hydrogen peroxide, water, and Tween 20 and teaches fluorinated sodium calcium pyrophosphate as optional ingredients.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the teachings of the combined references above by adding Tween 20 as a polysorbate type surfactant because of the expectation of obtaining a surfactant combination which serves as a solubilizing, dispersing, emulsifying, wetting, and viscosity-control agent, while effectively solubilizing flavorants.

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***Conclusion***

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within ~~TWO MONTHS of the mailing date of this final action and the advisory action is not~~ mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup  
Examiner  
Art Unit 1614



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Frederick Krass  
Primary Examiner  
Art Unit 1614



June 9, 2003